



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/405,046	09/27/99	NEADE	T A-58634-6/RF

FLEHR HOHBACH TEST
ALBRITTON & HERBERT LLP
FOUR EMBARCADERO CENTER
SUITE 3400
SAN FRANCISCO CA 94111-4187

HM22/0322

EXAMINER

JONES, D

ART UNIT	PAPER NUMBER
----------	--------------

1616

5

DATE MAILED: 03/22/00

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 30 days month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 1-11 is/are pending in the application.
- ☐ Of the above, claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claims 1-11 are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

Art Unit: 1616

ELECTION OF SPECIES

1. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows: various magnetic imaging agents as set forth in claims 1-11 wherein the contrast agent may comprise the variables M, A, B, C, D, X1-X4, R1-R12, W, X, Y, Z, S, T, U, V, H, I, J, K, L, and R13-R21 which range from a hydrogen atom, to single/double bonds, hydroxyl groups, carboxyl groups, blocking moieties, aryl groups, etc.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Note: The Examiner respectfully requests that the Applicant assign each variable the appropriate value when electing a species (i.e., X = hydrogen; Z = nitrogen; Y = -CH₃; etc.) and state which claims are drawn to the elected species.

2. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations

Art Unit: 1616

of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. Claims 1-11 are deemed to correspond to the species listed above.
4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features because the agent may contain different values assigned to the variables, M, A, B, C, D, X1-X4, R1-R12, W, X, Y, Z, S, T, U, V, H, I, J, K, L, and R13-R21, range from a hydrogen atom, to single/double bonds, hydroxyl groups, carboxyl groups, blocking moieties, aryl groups, etc. Hence, different chemical properties and a burdensome search would be necessary because one would have to search several different classes and subclasses.
5. A telephone call was made to Ms. Robin Silva on 3/10/00 to request an oral election to the above restriction requirement, but did not result in an election being made.
6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

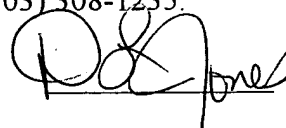
Art Unit: 1616

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

8. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to the Group 1600 fax machine at (703) 308-4556. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30; November 15, 1989.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. L. Jones whose telephone number is (703) 308-4640. Examiner Jones can generally be reached from Monday through Friday between 7:00 a.m. and 3:30 p.m. If the Examiner cannot be reached, questions may be addressed to her supervisor, Jose Dees, whose phone number is (703) 308-4628.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A handwritten signature in black ink, appearing to read 'D. L. Jones', is written over a horizontal line.

D. L. Jones
Patent Examiner
Art Unit, 1616

March 21, 2000